THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KNOX VAN DYKE

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Appeal No. 1995-2698
Application 07/660,807

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ON BRIEF

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Before Winters, William F. Smith, and Scheiner, Administrative Patent Judges.

William F. Smith, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 12, 18 through 20, 26, and 29 through 36, all the claims remaining in the application.

Our review of this case resulted in the discovery of a number of procedural errors on the part of the examiner which would normally preclude us from reaching a decision on the merits. However, our review has also led to the discovery of a particularly egregious substantive error on the part of the examiner. As a consequence, we will only outline the procedural errors we have uncovered and proceed to a decision on the merits.

Procedural Errors

Statements of Rejections

There are two rejections under 35 U.S.C. § 103 set forth in the Examiner's

Answer. The first rejection (Examiner's Answer, pages 4-7) appeared in the final rejection. The second rejection (Examiner's Answer, pages 7-10) is a new ground of rejection made in the Examiner's Answer. The heading for the first rejection reads as follows:

> Claims 1-12, 18-20, 26 and 29-36 are rejected under 35 U.S.C. 103 as being unpatentable over Miana et al, Fournet et al (R and S newly cited) and Ferrer Int SA in view of Mitscher et al, Neal et al (newly cited) and Applicants acknowledgement all of record or newly cited.

The heading for the new ground of rejection reads as follows:

> Claims 1-12, 18-20, 26 and 29-36 are rejected under 35 U.S.C. 103 as being unpatentable over Fournet et al. (R and S newly cited, references underlying the original Chemical Abstracts) in view of Neal et al, Riou et al (newly cited), Applicants acknowledgement and Mitscher et al, all of record or newly cited.
>
> The references underlying Fournet et al (R and S) are provided to clarify the rejection. Additionally, several references causing confusion as to the Examiners position have been replaced with Riou et al. Rational [sic] used in the rejection under 35 USC 103 is unchanged, but reformulated here to simplify the issues and expedite prosecution.

At the time of the final rejection, the Fournet references relied upon by the examiner appear to be citations from Chemical Abstracts. Attached to a "Supplemental Brief on Appeal" (Paper No. 20, September 27, 1993), are copies of the translated full text Fournet articles. It is not clear what the examiner means by the phrase "(R and S newly cited)" in describing the Fournet references in the first ground of rejection since it appears that the examiner relies upon the full text translations in the new ground of rejection in the Examiner's Answer. Thus, it is not clear what Fournet references are "newly cited" in regard to the first ground of rejection. The same confusion exists to the

examiner's citation of Neal in the first ground of rejection as being "newly cited." In relying upon Neal in the new ground of rejection, the examiner does not characterize Neal as "newly cited." Furthermore, the examiner's statement in regard to both rejections that reliance is placed upon "Applicants [sic] acknowledgement all of record or newly cited" is not understood. Is the examiner only relying upon so-called acknowledgements previously referenced during the examination process or is the examiner is relying upon additional "acknowledgements" for the first time in the Examiner's Answer?

There is further confusion in this record as to the references relied upon by the examiner. The first rejection relies upon a reference to Mitscher et al. As set forth on page 2 of the Examiner's Answer, this appears to be yet another Chemical Abstracts citation. However, there is a copy of the full text Mitscher article of record. Thus, it is not clear whether the examiner's consideration of the issues raised in the rejections has been based upon the abstract or the full text article.

It is not clear why the examiner did not withdraw the original rejection in view of the new ground of rejection. Suffice it to say that the examiner did not accomplish his stated goal of simplifying the issues and expediting prosecution by making the new ground of rejection.

Response to Reply Brief

Appellant filed a substantive response to the new ground of rejection by way of the Reply Brief of November 4, 1993 (Paper No. 21). The examiner

issued a communication on December 28, 1993 (Paper No. 22) stating that the Reply Brief had been entered and considered but no further response by the examiner was deemed necessary. This was error on the examiner's part.

Under the then existing provisions of MPEP § 1208.04, the examiner was to issue a Supplemental Examiner's Answer indicating whether the new ground of rejection had been overcome, and if not, setting forth the examiner's position in response. Absent a substantive response of the Reply Brief from the examiner, neither appellant nor this merits panel is in a position to determine what the examiner's position is.

Substantive Error

In arguing the existing rejection under 35 U.S.C. § 103 in the Appeal Brief, appellant relied upon the declaration of appellant Dr. Knox Van Dyke filed under 37 CFR § 1.132 as evidence of nonobviousness. See pages 13-14 of the Appeal Brief. The examiner did not mention or respond to this portion of appellant's position in the Examiner's Answer. Appellant made note of this shortcoming of the Examiner's Answer in the Reply Brief stating at page 7 that "the examiner does not even address this evidence in his [answer]." As set forth above, the examiner has not filed a substantive response to the Reply Brief.

As this record now stands, appellant relies upon objective evidence of nonobviousness in support of his position on appeal. Neither the Examiner's Answer nor the response to the Reply Brief addresses this evidence. This is legal error on the part of the examiner. As set forth in In re Hedges, 783 F.2d

1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

> If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Here, the examiner has not properly discharged his responsibilities in evaluating appellant's evidence of nonobviousness. This board serves a board of review. 35 U.S.C. § 6(b). Without a substantative response to appellant's evidence of nonobviousness, the examiner's position is not amenable to review. As a consequence, we will reverse the two pending rejections under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

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| Sherman D. Winters<br>Administrative Patent Judge | ) |
| William F. Smith<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| Toni R. Scheiner<br>Administrative Patent Judge | ) |

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